

## REMARKS

### Claim Objections

Claims 1, 2, 5, 6, 13-15, 18, 19, and 26 have been amended to correct the minor informalities. In each of claims 1, 2, 5, 6, and 13 the term “step” has been removed and replaced with a more descriptive element of the claim. The amendments are not entered to overcome the prior art.

Claims 27-39 have been added to more fully claim the invention.

All amendments and new claims are fully supported by the original disclosure. No new matter has been introduced.

Accordingly, Claims 1-39 are now pending.

### 101 Rejections

In the subject action, the Examiner rejected all of the claims as being directed towards “non-statutory subject matter” and that the “applicant’s invention as claimed is not limited to a practical application in the technological arts.”

With respect to the method claimed in independent Claim 1 and its dependant claims, Applicants respectfully disagree with the Examiner’s position interpreting claims that are not associated with structure are *per se* non-statutory under 35 U.S.C. §101 guidelines. Several cases support the Applicants’ view. A process claim is statutory when it states certain things are to be done with “certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.” See *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ 1, 10. (1981). A process employing an abstract idea is patentable subject matter even though an abstract idea would not, by itself, be entitled to such protection. See *State Street*

*Bank & Trust Co. v. Signature Financial Group Inc.* 47 USPQ2d 1596, 1602 (1998).

Statutory subject matter should be based on whether the operation produces a “useful, concrete and tangible result.” See *State Street Bank & Trust Co. v. Signature Financial Group Inc.* 47 USPQ2d 1596, 1603 (1998). The discussion in *State Street* goes on to state that “[t]he question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to – process, machine, manufacture, or composition of matter – but rather on the essential characteristics of the subject matter, in particular, its practical utility.” Id at 1603.

It appears, by focusing the discussion on some sort of nexus with “physical structure” the Examiner is concentrating on “some general, but no longer applicable legal principle, perhaps arising out of the ‘requirement for invention.’” The Supreme Court in *State Street* specifically stated, “[w]e take this opportunity to lay this ill-conceived exception to rest. Since its inception, the ‘business method’ exception has merely represented the application of some general, but no longer applicable legal principle, perhaps arising out of the ‘requirement for invention’—which was eliminated by Section 103. Since the 1952 Patent Act, business methods have been, and should have been, subject to the same legal requirements for patentability as applied to any other process or method.” Id at 1603.

What we have here is a method (process) for a user making a request and, related to that request, a sentence is dynamically constructed that relates to a user’s request by using a dynamic feedback of receiving an indication of concepts from the user. Based upon those concepts, related queries are selected and sent back to the user; those concepts are also used to construct and dynamically modify the sentence by selectively repeating the selection

process. The practical utility (as shown in the specification) is that, for example, a user may request to purchase goods or services, or make reservations for services, and in response the system server queries the user to determine the types of goods or services desired as well as other information such as a desired price. (See at least paragraph 17 of applicants' specification). The claims presently before the Examiner provide a practicable utility and are therefore statutorily in accord with the *State Street* analysis.

For at least the reasons articulated above, Applicants respectfully request the Examiner withdraw the 35 U.S.C § 101 rejections against Claims 1-13, as the claims are clearly directed towards "useful" things and, therefore, are directed towards statutory subject matter.

With respect to the apparatus Claim 14, and its dependant claims, Applicants respectfully assert that the preamble including "An apparatus for..." clearly shows that the claimed invention is not an abstract idea, but a physical invention that performs a specific function. Specifically, the apparatus includes a receive module for receiving an indication of concepts from a user; and a select module for selecting related queries to present to the user based upon the concepts, to dynamically construct a sentence relating to the user request. One generally skilled in the art would be able, from the disclosure and claims, to practice the invention. Additionally, Applicant restates each of the relevant reasoning and arguments presented above for Claims 1-13.

For at least the reasons articulated above, Applicants respectfully request the Examiner withdraw the 35 U.S.C § 101 rejections against Claims 14-26, as the claims are

- clearly directed towards “useful” things and, therefore, are directed towards statutory subject matter.

### **New Claims 27-39**

New Claim 27 recites “A computing device implemented method ...” that in all other ways follows Claim 1. Applicants note, while still strongly traversing Examiner’s rejection of Claims 1-26, that this preamble is in accord with suggestions in the last office action. Therefore, Claim 27 is clearly allowable under 35 U.S.C. § 101. Claims 28-39 each depend on Claim 27, incorporating its limitations. Therefore, for at least the same reasons, Claims 28-39 are patentable under 35 U.S.C. § 101.

### **CONCLUSION**

As a result, Applicants submit that all of the pending claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1504. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge Deposit Account No. 500393.

Respectfully submitted,  
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